

## **II. REMARKS**

Applicant gratefully acknowledges that the Examiner has allowed claims 12 and 13 (Office Action, mailed August 12, 2009, at 5, lines 12-13).

By the present amendment, new claims 19-22 have been added. More specifically, new independent claim 19 incorporates subject matter from previous claims 10, 15 and 18. New claim 20 depends upon claim 19, and recites subject matter supported by previous claim 17. New claims 21 and 22 depend upon claims 10 and 19, respectively, and further recite that “the actuating lever is meshed, directly or indirectly, with the first mechanism so as to correct information provided by the first mechanism” as supported on page 4, lines 15-17, of Applicant’s specification as originally filed.

The present amendment adds no new matter to the above-captioned application.

### **A. The Invention**

The present invention pertains broadly to a control device for a timepiece for activating a first mechanism, wherein the timepiece comprises a case delimiting a volume. In accordance with an embodiment of the present invention, a control device for a timepiece for activating a first mechanism, wherein the timepiece comprises a case delimiting a volume, is provided wherein the control device includes limitations recited by independent claim 10. In accordance with another embodiment of the present invention, a control device for a timepiece for activating a first mechanism, wherein the timepiece comprises a case delimiting a volume, is provided wherein the control device includes limitations recited by independent claim 12. In accordance with yet another embodiment of the present invention, a control device for a timepiece for activating a first mechanism, wherein the timepiece comprises a case delimiting a volume, is provided wherein the control device includes limitations recited

by independent claim 19. Various other embodiments, in accordance with the present invention, are recited by the dependent claims.

An advantage provided by the various embodiments of the present invention is that a control device for a timepiece for activating a first mechanism, wherein the timepiece comprises a case delimiting a volume, is provided wherein the control device may be actuated very simply by means of a finger or fingernail so that no tools are necessary to operate the control device. Furthermore, a control device, in accordance with the present invention, provides an alternative to miniature push-buttons used as control devices.

**B. The Rejections**

Claims 10 and 11 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Ito (U.S. Patent 4,126,796, hereafter the “Ito Patent”).

Claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the Ito Patent in view of Eray (U.S. Patent 5,751,668, hereafter the “Eray Patent”). Claims 15-17 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the Ito Patent in view of Kitai (U.S. Patent 3,780,525, hereafter the “Kitai Patent”). Claim 18 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the Ito Patent.

Applicant respectfully traverses the Examiner’s rejections and requests reconsideration of the above-captioned application for the following reasons.

**C. Applicant’s Arguments**

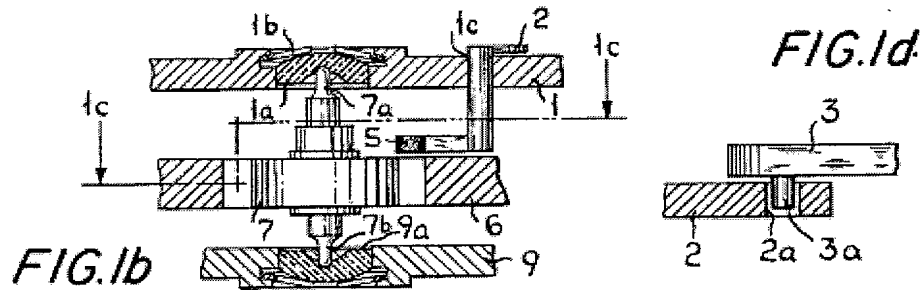
Claims 12 and 13 have been allowed.

**i. The Rejection Under 35 USC §102**

Anticipation under 35 U.S.C. § 102 requires showing the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). In this case, the Examiner has failed to establish a prima facie case of anticipation against independent claim 10 because the Ito Patent fails to teach, or even suggest, each and every element recited by claim 10. In particular, the Ito Patent does not teach, or even suggest, “an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism” as recited by independent claims 10 and 19.

**ii. The Ito Patent**

The Ito Patent discloses a “miniature reversible motor” that comprises a rotor (7) having a plurality of magnetic pole pairs, and a stator (6) having a pole face opposite the periphery of the rotor, wherein a magnetic member (5) of high permeability magnetic material is positioned proximate the periphery of the rotor (7) and magnetically couples with the magnetic poles of the rotor for determining a direction of rotation of the rotor (See Abstract of the Ito Patent, and col. 1, lines 45-60). The Ito Patent discloses that a positioning mechanism, as shown in Fig. 1d, is operable for changing the position of the magnetic member (5) relative to the periphery of the rotor (7) to change the direction of rotation of the rotor determined by the relative position of the magnetic member and the periphery of the rotor (See Abstract of the Ito Patent, and col. 1, lines 35-37, and Figs. 1b and 1d). Figs. 1b and 1d of the Ito Patent are reproduced below for convenient reference.



The Ito Patent does not teach, or even suggest, “an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism” as recited by independent claim 10. Specifically, the Ito Patent does not teach, or suggest, an actuating lever “meshed” with a first mechanism. According to the Ito Patent, the magnetic member (5) is mounted at the end of a rotary lever (2) as shown in Fig. 1b, wherein the magnetic member (5) is located close to the outer periphery of the rotor (7) and is located above the rotor (7), (Ito Patent, col. 2, lines 5-10). A manual lever (3) may be operated from outside of the watch and is connected to the rotary lever (2), (Ito Patent, col. 1, lines 49-52). The rotary lever (2) can be rotated in two opposite directions as evident from Fig. 1a of the Ito Patent. The Ito Patent discloses that the magnetic member (5) reverses the direction of rotation of the rotor (7) as a function of the direction in which the lever (2) is rotated (Ito Patent, col.2, lines 11-40).

Based on the above facts, a person of ordinary skill in the art would immediately understand that the magnetic member (5) is magnetically linked with the rotor (7). There is no physical contact that exists whatsoever between the magnetic member (5) and the rotor (7). On the contrary, it is necessary for all physical contact, i.e., all mechanical contact, between the magnetic member (5) and the rotor (7) be avoided; otherwise, the rotation of the rotor (7) will be impaired.

The Examiner erroneously contends that the lever containing magnetic member (5) of Ito’s device is an “actuating lever” that is indirectly meshed via case (1, 6 and 9) with rotor

(7), which the Examiner contends may be construed as the “first mechanism” recited by Applicant’s claim 10 (See, e.g., Office Action, dated February 22, 2010, at 2, line 17, to page 3, line 3). The Examiner’s contention is flawed on its face, and must be withdrawn, because the case, comprising elements (1), (6) and (9), is a fixed component that cannot “mesh” with an actuating lever” recited by independent claims 10 and 19.

**a. The Term “Meshed” Cannot be Reasonably Construed  
to Apply to a Case and an Actuating Lever**

The Examiner argues that the term “meshed” means “interconnected, engaged or interlocked” and that the claims read broadly on indirect meshing of the component parts (Office Action, dated February 22, 2010, at 6, lines 8-10). Applicant respectfully traverses the Examiner’s interpretation of the term “meshed” as used in Applicant’s specification and claims on the grounds that the Examiner’s interpretation is unduly broad, inaccurate and/or incorrect for the following reasons.

First of all, Applicant is not obligated to adopt the Examiner’s definition of “meshed” as “interconnected, engaged or interlocked.” Second, the Examiner has provided no factual basis in support of the Examiner’s alleged definition.

It is a well-settled proposition that each claim term is given its meaning to a person of ordinary skill in the art based on a reading of the specification, although dictionaries and comparable sources may be used to assist in the understanding the commonly understood meaning of words that is not inconsistent with the specification. Phillips v. AWH Corporation, 415 F.3d 1303, 1321-24 (Fed Cir. 2005). In this case, Applicant’s original specification, page 4, lines 15-20, describes “corrector lever 48...meshed, directly or indirectly, with indicator mechanism 46,” which is a relationship schematically shown in Figure 1. A person of ordinary skill in the art would immediately realize, upon reading

Applicant's specification and drawings, that Applicant has ascribed no special definition to the term "meshed," but has relied upon its ordinary meaning in the art.

Applicant files herewith evidence demonstrating the meaning of the term "meshed" as it would be understood by a person of ordinary skill in the art. For example, the ordinary meaning of the term "mesh" includes "to be in or come into mesh – used esp. of gears" (See, e.g., WEBSTER'S NEW COLLEGIATE DICTIONARY 720 (1977), a copy of which is filed herewith as "Exhibit A"). In addition, the term "mesh" has an art recognized meaning in the field of horology, which is the "[a]ct of engaging, connecting" with respect to gears (See, e.g., ILLUSTRATED PROFESSIONAL DICTIONARY OF HOROLOGY I + II 909 (2002), a copy of which is filed herewith as "Exhibit B").

Because the present invention pertains to the field of horology, and because the invention pertains to an assembly that involves moving parts, a person of ordinary skill in the art would understand from Applicant's specification and drawings, and from Exhibits A and B, that the term "meshed," as used in Applicant's disclosure, would be understood according to its ordinary meaning to one of ordinary skill in the art, which is "to be in or come into mesh, which is the act of engaging or connecting gears." Applicant understands that the Examiner has broadly construed the term "meshed" to include connecting a lever to a housing or case. However, such an interpretation is not consistent with the term "meshed" as used in Applicant's specification, and it is not in accord with the ordinary use of the term in the field of horology, wherein the term "meshed" applies to connecting or engaging gears.

In other words, as used in Applicant's specification and claims, and in accordance with the meaning of the term "meshed" in the field of horology, the claim phrase "an actuating lever...meshed, directly or indirectly, with the first mechanism" pertains to an actuating lever that is engaging or connecting, directly or indirectly, to gears of the first mechanism." As would be immediately understood by a person of ordinary skill in the art, a

lever cannot indirectly engage or connect to gears of a mechanism via a stationary, fixed structure such as Ito's case (i.e., elements (1), (6) and (9)). Therefore, it is not reasonable to construe Ito's lever, which contains magnetic member (5), as indirectly meshing with gears of any mechanism via the fixed, non-mobile case comprising components (1), (6) and (9).

Applicant encourages the Examiner to give the broadest reasonable interpretation to the claim term "meshed" that is consistent with Applicant's specification, In re Hyatt, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000). However, the Examiner's interpretation wherein lever (5) meshes indirectly with rotor (7) via the case (1), (6), (9) makes no sense and is, therefore, unreasonable when viewed in the light of Applicant's specification, drawings, and Exhibits A and B.

For all of the above reasons, the Ito Patent does not teach, or suggest, (i) "an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism" as recited by independent claim 10. Furthermore, it would not be obvious to modify the device disclosed by the Ito Patent so that it includes an actuating lever that is mechanically linked to the rotor (7) because such a feature would interfere with the operation of the mechanism that allows the rotor to rotate normally in the normal condition while allowing the rotor (7) to reversibly rotate when the manual lever (3) is moved (See Ito Patent, col., 2, lines 31-40).

The Ito Patent also does not teach, or even suggest, that "the actuating lever is meshed, directly or indirectly, with the first mechanism so as to correct information provided by the first mechanism" as recited by claims 21 and 22.

For all of the above reasons, Applicant has shown that the Ito Patent is insufficient to establish either a prima facie case of anticipation, or of obviousness, against claims 10 and 11.

**iii. The Rejection under 35 USC §103(a)**

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In the present case, the Examiner has failed to establish a prima facie case of obviousness against claims 10, 11 and 14-22 because the combination of the Ito Patent, the Eray Patent and Kitai Patent fails to teach, or even suggest, “an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism” as recited by independent claims 10 and 19.

**iv. The Ito Patent**

The disclosure of the Ito Patent is discussed above. As admitted by the Examiner (Office Action, dated August 12, 2009, at 3, lines 14-16; at 4, lines 5-9; and at 5, lines 2-4), the Ito Patent does not teach, or even suggest, (ii) “the stem has a groove that houses a sealing gasket” as recited by claim 14, (iii) “the actuating lever cooperates with a corrector lever that is meshed with the first mechanism, and the first mechanism is an indicator mechanism” as recited by claim 15, (iv) “the corrector lever exerts an elastic return force on the actuating lever” as recited by claim 16, (v) “the control lever is embedded in a hollow arranged in a horn of the case” as recited by claim 17, and (vi) “the general axis of symmetry extends perpendicularly or parallel to a mid-plane in which there extends a movement of a timepiece” as recited by claim 18.



**v. The Eray Patent**

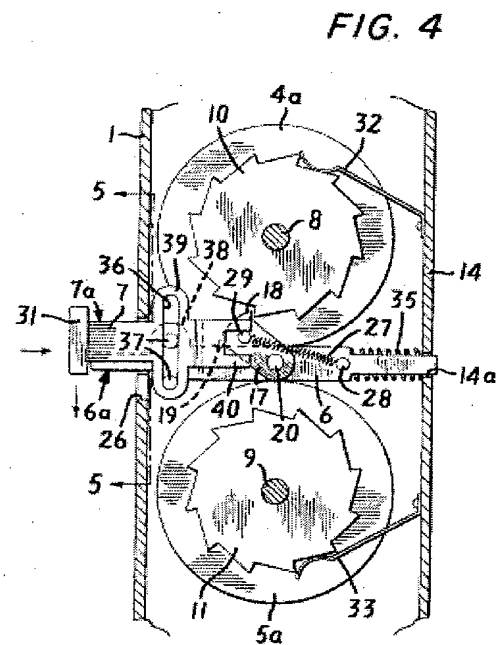
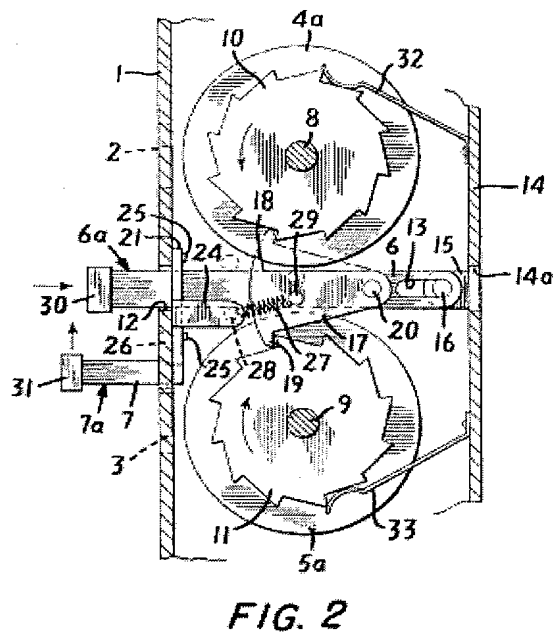
The Eray Patent discloses a “push button and method for assembling such push button,” wherein, as shown in Figure 1, the push button comprises a stem (10), provided with a head (5) able to be manipulated and sliding into an opening (2) provided in the middle part (3) of a timepiece, and stopping means preventing the removal of the stem (10), wherein the stem (10) comprises, on the head side (5), a main cylindrical body (11) extended by a shank (13) separated from the latter by a groove (12) intended to receive an O-ring sealing gasket (30), wherein the shank (13) has at its end an axial stud (17) ending in an annular rim (18), and the stopping means comprise a sleeve (20) inserted between the wall of the opening (2) and the shank (13), partially blocked by a ring (22) of greater external diameter than that of the opening (2) and of substantially equal aperture to the diameter of the stud (17), wherein the sleeve (20) compresses the O-ring sealing gasket (30) and is fixed to the shank (13) by riveting of the annular rim (18), (See Abstract of the Eray Patent).

**vi. The Kitai Patent**

The Kitai Patent discloses “setting means for indicating apparatus,” as shown in Figures 1-4, wherein the setting means is intended for use in a digital indicating apparatus, for example, a digital clock having a plurality of coaxial indicating display wheels (4a), (4b), (4c), and a like plurality of coaxial reference display wheels (5a), (5b), (5c), wherein the setting means comprises a ratchet wheel (10) fixed on each of the display wheels and a single reciprocable setting member (6a) located between each of the indicating display wheels and the corresponding reference display wheel (See Abstract of the Kitai Patent, and col. 2, lines

10-34; col. 3, lines 1-31). Figures 2 and 4 of the Kitai Patent are reproduced below for reference.

The Kitai Patent discloses a pawl (17) pivotally mounted on the setting member (6a) and movable between a first position in which it is engageable with the ratchet wheel (10) of the respective indicating display wheel and a second position in which it is engageable with the ratchet wheel (11) of the corresponding reference display wheel (Abstract of the Kitai Patent, and col. 3, lines 25-48). The pawl (17) is shifted from one position to the other by manually operable changeover means (7a) so that the same setting member (6a) is operable



to rotate either the indicating display wheel or the corresponding reference display wheel to the desired setting (See Abstract of the Kitai Patent, and col. 3, lines 49-55).

#### **vii. Summary of the Disclosures**

The combined disclosures of the Ito Patent, the Eray Patent, and the Kitai Patent does not teach, or even suggest, “an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism” as recited by independent claims 10

and 19. The combined disclosures of the Ito Patent, the Eray Patent, and the Kitai Patent also does not teach, or suggest, “wherein the actuating lever is meshed, directly or indirectly, with the first mechanism so as to correct information provided by the first mechanism” as recited by claims 21 and 22. Therefore, the Examiner has failed to establish a prima facie case of obviousness against claims 10, 11 and 14-22.

**viii. No Legitimate Reason to Combine the Disclosures of the Ito Patent, the Eray Patent and the Kitai Patent**

A proper rejection under Section 103 requires showing (1) that a person of ordinary skill in the art would have had a legitimate reason to attempt to make the composition or device, or to carry out the claimed process, and (2) that the person of ordinary skill in the art would have had a reasonable expectation of success in doing so. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this case, the Examiner has (1) failed to establish a legitimate reason for combining the disclosures of the Ito Patent, the Eray Patent and the Kitai Patent, and (2) has failed to demonstrate that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at Applicant’s claimed invention even if the combination was made. Therefore, the Examiner has failed to establish a prima facie case of obviousness against claims 15-17, 19, 20 and 22.

Specifically, the Ito Patent does not disclose “an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism” as recited by independent claims 10 and 19. The Ito Patent discloses a rotary lever (2) provided with a magnetic member (5) mounted at an end of the rotary lever (2) as shown in Fig. 1b. The Ito Patent discloses changing the position of the magnetic member (5) relative to the periphery of a rotor (7) to change the direction of rotation of the rotor based on the relative position of the magnetic member and the periphery of the rotor (See Abstract of the Ito Patent, and col. 1,

lines 35-37, and Figs. 1b and 1d). Therefore, the Ito Patent discloses contactless, magnetic cooperation between the manual lever (2) and the rotor (7) so as to provide a mechanism for changing the direction of rotation of the rotor (7).

The Kitai Patent discloses a pawl (17) that shifts from one position to another by manually operating changeover means (7a) so that the same setting member (6a) is operable to rotate either the indicating display wheel or the corresponding reference display wheel to the desired setting (See Abstract of the Kitai Patent, and col. 3, lines 49-55). Thus, the Kitai Patent discloses a mechanically linked system for operating one display wheel or another display wheel.

A person of ordinary skill in the art would realize that the Examiner has no legitimate reason to justify the combination of the Ito Patent and the Kitai Patent because the mechanisms disclosed by the Ito Patent and the Kitai Patent are substantially different in structure and function. Specifically, the mechanism disclosed by the Ito Patent utilizes magnetism to form a magnetic link between the lever (2) and the rotor (7). On the other hand, the mechanism disclosed by the Ito Patent utilizes mechanical parts, namely a pawl (17), to link changeover means (7a) to two wheels (5a) and (5b). Thus, the structure disclosed by the mechanisms disclosed by the Ito Patent and the Kitai Patent are substantially different.

In addition, the mechanism disclosed by the Ito Patent operates to switch the direction of the rotor (7), (i.e., a wheel). The Kitai Patent, on the other hand, provides a mechanism for switching operation between two wheels (5a), (5b) so that only one of the two wheels is operated at a time. The Kitai Patent does not teach, or even suggest, reversing the rotation of the two display wheels (4a) and (5a). Therefore, the mechanisms disclosed by the Ito Patent and the Kitai Patent are substantially different in function.

In view of the above facts, a person of ordinary skill in the art would have absolutely no reason to combine the disclosures of the Ito Patent and the Kitai Patent because the mechanisms disclosed by these two patents are substantially different in structure and function. Based on the disclosure of the Kitai Patent, a person of ordinary skill in the art would not be motivated to transform Ito's contactless, magnetic mechanism into a contact effective mechanism utilizing a pawl because the mechanical mechanism disclosed by the Kitai Patent does not pertain to a mechanism for changing the direction of rotation of a wheel.

Furthermore, a person of ordinary skill in the art would not have had a reasonable expectation of success of obtaining Applicant's claimed invention, or any operable device, even if the combination of the Ito Patent and the Kitai Patent was made. In particular, it would be unclear to a person of ordinary skill in the art how to apply the pawl (17) disclosed by the Kitai Patent to the rotor (7) disclosed by the Ito Patent because the device disclosed by the Ito Patent has only one rotor (7) and the changeover means (6a) employed by the Kitai Patent is used to change rotation from one display wheel to another display wheel. In other words, because the mechanism disclosed by the Ito Patent pertains to a single rotor (7), it is unclear how Kitai's pawl (17) could be applied to such a mechanism because the Kitai's pawl (7) is used to switch rotation between two wheels and not switch the rotation direction of a single wheel. The Eray Patent does not make up these deficiencies with respect to the disclosures of the Ito Patent and the Eray Patent.

For all of the above reasons, the Examiner has failed to establish to establish a prima facie case of obviousness against claims 15-17, 19, 20 and 22. **Because the Examiner has not contested the above arguments, as set forth on page 12, line 1, to page 14, line 16, of Amendment (C) filed on December 8, 2009, the Examiner implicitly concedes them.**

### III. CONCLUSION

Claims 12 and 13 have been allowed. The Examiner has failed to establish a prima facie case of anticipation, or of obviousness, against claims 10, 11 and 14-22 because the Ito Patent, either alone or in combination with the Eray Patent and the Kitai Patent, does not teach, or even suggest, “an actuating lever located inside the volume of the case and meshed, directly or indirectly, with the first mechanism” as recited by independent claims 10 and 19. Furthermore, as implicitly conceded by the Examiner, the Examiner has failed to establish any legitimate reason to justify the combination of the Ito Patent and the Kitai Patent, and the Examiner has failed to demonstrate that a person of ordinary skill in the art would have enjoyed a reasonable expectation of success of arriving at Applicant’s claimed invention even if the combination was made.

For all of the above reasons, claims 10-22 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

The below-signed attorney for Applicant welcomes any questions.

Respectfully submitted,

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